

Appl. No. 10/758,067
Amdt. dated July 17, 2006
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 2625

PATENT

REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed April 18, 2006. Claims 20-32 were pending in the present application. This Amendment amends claims 20, 22, 25, and 29, without adding or canceling any claims, leaving pending in the application claims 20-32. Reconsideration of the rejected claims is respectfully requested.

I. Rejection under 35 U.S.C. §112

Claims 25-32 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. In particular, the Office Action rejects the limitation "the storing of [the] image data in the at least one database is separate from the transmission of the email document to the destination" as not being described in the specification in such a way as to reasonably convey to one of ordinary skill in the art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants respectfully point the Examiner to page 12, lines 17-19, wherein the specification states that the "configuration file can be configured so that the email hub 116 sends a copy of every message sent and received by a user, including the origin and destination addresses and the date and time of transmission, to the document management workstation 108." This transmission of a copy of a message to the document management workstation is not the same transmission as that used to transmit the original message to or from the user, and the storing of the image data from the message is based on the copy sent to the document management workstation, such that the storing of image data in the at least one database is separate from the transmission of the original message to the destination as recited in the claim. Further, it is respectfully submitted that using an email hub to send a copy of a message to a separate destination is well known in the art, and approaches for implementing such functionality in the claimed embodiment would be apparent to one of ordinary skill in the art in light of the specification. Applicants therefore respectfully submit that the rejected limitation is adequately described in the specification, and request that the rejection with respect to claims 25-32 be withdrawn.

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II. Rejection under 35 U.S.C. §102

Claims 25-27 and 29-31 are rejected under 35 U.S.C. §102(e) as being anticipated by *Todd* (US 5,890,163). Applicants respectfully submit that *Todd* does not disclose each element of these claims.

For example, Applicants' claim 25 as amended recites an email server for performing unconscious archiving of electronic documents in a network environment, wherein electronic documents are transferred over a network coupling at least one client computer and at least one document management workstation having at least one database disposed to receive electronic copies of said documents for archiving, said server operatively disposed to:

collect electronic image data of an email document transmitted over the network, the email document transmitted over the network, wherein the email document was transmitted in response to a single user input command configured to transmit the email document to a destination, the electronic image data being a copy of the email document transmitted over the network;

cause said image data to be stored in the at least one database to perform the unconscious capture archiving, wherein the aforementioned steps are carried out without further input from the user notwithstanding the single user input command for transmitting the email document to a destination, wherein the storing of said image data in the at least one database is separate from the transmission of the email document to the destination and transparent to the user

(emphasis added). Applicants respectfully submit that such limitations are not disclosed by *Todd*.

Todd discloses an electronic mail archiver wherein a user can identify an electronic mail message to be archived (col. 2, lines 7-16), either by selecting specific messages or selecting an option to archive all messages (col. 2, lines 17-41). The decision to archive a message is a conscious decision, as the user must select an option to archive a message before any message is archived. This is not an unconscious decision, and is not transparent to the user. Further, this archiving is not done via a single user input command for transmitting an email document to a destination, where the single user input is a "send" or similar command as known in the art for transmitting email messages. A selection to archive all messages, for example, must be done separately from input commands to individually transmit individual messages over time.

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The Examiner asserts on page 6 that the unconscious archiving of data as recited in Applicants' claim is equivalent to the automatic archiving of *Todd*. Applicants respectfully submit that "unconscious" and "automatic" are not equivalent in this context, as a user of the *Todd* system must first select to archive a message or messages for that user, after which the message(s) are archived automatically ("without intervention by the user"). This archiving is not done unconsciously or transparent to the user, as the user of *Todd* has to consciously select to archive a message or a message will not be archived. Applicants' claim recites that archiving of data for a message, for example, is archived without any user input other than a transmit input, and done transparent to a user, whereby message data is archived without any indication or knowledge of the user being required. *Todd* requires the user to make a selection, which is separate from a transmission input and clearly not transparent or unconscious to the user. Even after a user in *Todd* has selected an option to archive all messages, and any subsequent "transmit" or similar input afterwards could result in the transmitted message being automatically archived without any additional input, the user still must have first made a separate, conscious selection to archive the messages, and hence does not meet the limitations of the above claim.

As *Todd* does not disclose the limitations of these claims, *Todd* cannot anticipate claim 25 or dependent claims 26 and 27. Claim 29 recites limitations which similarly are not disclosed by *Todd*, such that *Todd* cannot anticipate Applicants' claim 29 or dependent claims 30 and 31. Applicants therefore respectfully request that the rejection with respect to claims 25-27 and 29-31 be withdrawn.

III. Rejection under 35 U.S.C. §103

Claims 20-24, 28, and 32 are rejected under 35 U.S.C. §103(a) as being obvious over *Todd* in view of *Bellemare* (US 5,701,183). Applicants respectfully submit that these references do not teach or suggest each element of these claims.

As discussed above, *Todd* teaches the conscious selection by a user to archive a message or messages, which is separate from the selection by a user to transmit a message. As such, the archiving is not unconscious or transparent to the user, and is not done with a single user input

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command to transmit a message to a destination as recited in Applicants' claims 20, 22, 25, and 29. As such, *Todd* cannot render obvious claims 20, 22, 25, and 29, or the claims that depend therefrom.

Bellemare does not make up for the deficiencies in *Todd* with respect to claims 20, 22, 25, and 29. *Bellemare* teaches a system for selective archiving of facsimile messages (col. 1, line 41-col. 2, line 39; Abstract), and is cited as teaching the same (OA p. 5). *Bellemare* does not, however, teach or suggest a server operatively disposed to "collect electronic image data of an email document transmitted over the network," wherein the "email document was transmitted in response to a single user input command configured to transmit the email document to a destination," or disposed to "cause said image data to be stored in the at least one database to perform the unconscious capture archiving," without further input from the user "notwithstanding the single user input command for transmitting the email document to a destination," and wherein the storing of said image data in the database is "transparent to the user." As such, the teachings of *Bellemare* cannot make up for the deficiencies in *Todd* with respect to claims 20, 22, 25, and 29, and the claims that depend therefrom. As *Todd* and *Bellemare* do not teach or suggest the limitations of these claims, either alone or in combination, Applicants respectfully submit that *Todd* and *Bellemare* cannot render obvious these claims, and respectfully request that the rejection with respect to claims 20-24, 28, and 32 be withdrawn.

IV. Amendment to the Claims

Unless otherwise specified, amendments to the claims are made for purposes of clarity, and are not intended to alter the scope of the claims or limit any equivalents thereof. The amendments are supported by the specification and do not add new matter.

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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 415-576-0200.

Respectfully submitted,



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